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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,993	06/27/2001	Kelly R. Brown	ETH-1567	3764
27614	7590	10/06/2004	EXAMINER	
RALPH W. SELITTO, JR. C/O MCCARTER & ENGLISH, LLP GATEWAY CENTER FOUR 100 MULBERRY STREET NEWARK, NJ 07102			FUBARA, BLESSING M	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/892,993	<b>Applicant(s)</b> BROWN ET AL.	
	<b>Examiner</b> Blessing M. Fubara	<b>Art Unit</b> 1615	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/18/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Examiner acknowledges receipt of IDS filed 05/18/04, request for extension of time filed 07/15/04, amendment and remarks filed 07/15/04 and terminal disclaimer filed 07/15/04.

Claims 1-4 and 6-28 are pending.

#### *Claim Rejections - 35 USC § 102*

1. Claims 1-4, 6-17, 23 and 24 remain rejected under 35 U.S.C. 102(e) as being anticipated by Vyakarnam et al. (US 6,333,029).

Applicants argue that Vyakarnam does not disclose a polymer foam that interlocks with a ceramic body.

2. Applicants' arguments filed 07/15/04 have been fully considered but they are not persuasive. Vyakarnam discloses polymer that is porous and is a foam and does not exclude that the polymer is interacting with the ceramic body. Specifically, Vyakarnam discloses a lyophilization process and the instant application in paragraph [0022] states that choosing appropriate conditions during the lyophilization process controls the polymer phase and the polymer foam is directly lyophilized into the ceramic structure. **“This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.”**

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***Claim Rejections - 35 USC § 103***

3. Claims 1-4 and 6-22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Tormalia et al. (US 5,084,052) in view of Vyakarnam et al. (US 6,333,029).
4. Claims 18-22 and 25-28 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Vyakarnam et al. (US 6,333,029).

Applicants in response to the above rejections under 35 USC 103 state that “applicants file herewith a Statement of Common Ownership, stating that the present application and the Vyakarnam Patent were owned by the same entity (i.e., Ethicon, Inc.) at the time that the invention was made. As provided for in 35 U.S.C. 103 (c), such a declaration is effective to overcome a § 103 (a) rejection, since Vyakarnam Patent prior art under § 102(c).”

However, applicants failed to file the declaration. The above statement does not in itself constitute a declaration. Applicants may submit the signed declaration stating that present application and the Vyakarnam Patent were owned by the same entity (i.e., Ethicon, Inc.) at the time that the invention was made. That signed declaration will remove the Vyakarnam reference as prior art under 35 USC 102(e) as stated in the rejection and thus removes it also from the 35 USC 103 rejections. A mere statement without the signed declaration does not constitute removal of the Vyakarnam reference as art. It was stated at the beginning of the 35 USC 102 rejection as follows:

“The applied reference has a common inventor/assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). **This rejection under 35 U.S.C. 102(e) might be overcome either by a**

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**showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131."**

***Double Patenting***

5. The rejection of claims 1-4 and 6-24 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,626,950 is withdrawn because applicants' terminal disclaimer overcomes the rejection.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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